

REMARKS

Claims 1-8, 11, 14 and 15 are the only claims pending. Claims 7 and 15 are cancelled due to a restriction requirement.

Claim 1 is currently amended to delete the term "kojic acid" from the list of components for component (b).

Additionally, claim 1 is currently amended to correct the concentration requirement of component (b). Support for this amendment is located in the specification in paragraph [0156] of US 2006/0216252, the pre-grant publication of the instant invention.

No new matter has been added.

Claims 1-6, 8, 11 and 14 are presented for reconsideration.

Claim Rejections – 35 USC 103(a)

Claims 1-6, 8, 11 and 14 remain rejected under 35 USC 103(a) as being unpatentable over Hague (WO 2001/70189) in view of Sakoda et al. (WO 1998/17247) and Ashby et al (*Regul. Toxicol. Pharmacol.* **2001** 34(3), 287-291).

Instant claim 1 is currently amended to delete the term "kojic acid" from the list of components for component (b).

WO 2001/70189 discloses methods and compositions for lightening the skin color comprising an alpha- or beta-hydroxy substituted carboxylic acid, an antimicrobial agent, a sunscreen agent and a pharmaceutically acceptable carrier. Suitable sunscreen agents are listed on pages 9-12. WO 2001/70189 is totally silent with regard to the use of triazine UV absorbers in skin lightening methods or skin lightening compositions.

WO 1998/17247 discloses methods and compositions for lightening mammalian skin comprising kojic acid, salicylic acid, water and a water soluble glycol ether. Optional additional ingredients are listed on

pages 4-7. Included in these optional ingredients are water-soluble ultraviolet and infrared screening and absorbing agents. WO 1998/17247 gives no guidance or motivation and is totally silent as to the use of triazine UV absorbers in skin lightening methods or skin lightening compositions.

Ashby et al (*Regul. Toxicol. Pharmacol.* **2001** 34(3), 287-291) discloses a study investigating the response of two sunscreen components in estrogen receptor and androgen receptor binding assays *in vitro*. Tinosorb M and Tinosorb S are also evaluated in immature rat uterotrophic assays using a subcutaneous route of administration. It is concluded from this study that neither of these two sunscreen components are likely to act as hormonal mimics in animals. Ashby et al. does not provide any guidance or motivation as to what compositions or methods to incorporate these sunscreen components into. Furthermore, Ashby et al. is totally silent with regard to what type of applications these sunscreen components are to be used in.

The instant amended claims provide a method for inhibiting melanogenesis and for lightening skin which comprises contacting said skin with a composition comprising a halogenated hydroxydiphenyl ether of component (a) and a skin lightening substance of component (b) and a triazine UV absorber of component (c). The compound "kojic acid" is deleted from the list of components in component (b).

Without knowledge of the instant invention said invention is unobvious for a person skilled in the art because without teaching and motivation in the cited prior art or any other useful hints and without substantial testing no person skilled in the art could expect the advantageous properties of the instant invention.

The limitations of the instant amended claims can not be derived from the combination of WO 2001/70189, WO 1998/17247 and Ashby et al (*Regul. Toxicol. Pharmacol.* **2001** 34(3), 287-291) either alone or collectively; hence the limitations are not met.

From the teachings of WO 2001/70189, WO 1998/17247 and Ashby et al (*Regul. Toxicol. Pharmacol.* **2001** 34(3), 287-291) either alone or in combination, a person of ordinary skill could not have predicted these surprising results and superior skin lightening properties of the instant invention.

The present 35 USC 103(a) rejection is addressed and is overcome.

Claim Rejections – 35 USC 112, First Paragraph

Claims 1-6, 8, 11 and 14 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

Claim 1 is currently amended to the concentration range of component (b) to 0.01% to 2% which is found in the specification in paragraph [0156] of US 2006/0216252, the pre-grant publication of the instant invention.

The present 35 USC 112 first paragraph rejection is addressed and is overcome.

The Examiner is kindly requested to reconsider and to withdraw the present objections and rejections.

Applicants submit that the present claims are in condition for allowance and respectfully request that they be found allowable.

Respectfully submitted,



for

Mervin G. Wood, Ph.D.
Agent for Applicants
Reg. No. 56,711

TYLER STEVENSON
Reg No 46388

Ciba Corporation
Patent Department
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591-9005
Phone: (914) 785-7113
Fax (914) 785-7102
MGW22918A2